

REMARKS

Upon entry of the present amendment, claim 2 will be canceled without prejudice or disclaimer of the subject matter recited therein; claims 1, 4-6 and 10 will be amended; and claims 15-20 will be added, whereby claims 1 and 3-20 will be pending.

Support for the amendment to the claims appears in the originally filed application, including the originally filed claims, including claims 2, 5, 6, 9 and 10.

Reconsideration of the objection and rejections of record and allowance of the application are respectfully requested.

Response To Allowable Subject Matter

Applicants express appreciation for the indicated allowability of claims 5 and 9. By amendment herein, new claims 19 and 20 have been added substantially including the allowed subject matter, whereby these claims should be indicated to be allowable over the prior art of record.

However, for the reasons set forth herein, each of the pending claims is patentable over the prior art of record, whereby each of the pending claims should be indicated to be allowable.

Claim of Foreign Priority

Applicants express appreciation for the acknowledgement of the claim of foreign priority as well as receipt of the certified copy in this national stage application.

Information Disclosure Statement

Applicants express appreciation for the Examiner's confirmation of consideration of Applicants' Information Disclosure Statement, filed May 8, 2006, and Supplemental Information Disclosure Statement, filed August 10, 2006, by including initialed copies of the Forms PTO-1449 with the Office Action.

However, it is noted that the Examiner has drawn a line through Citation 10 on the May 8, 2006 form. The Office Action is silent with respect to any reason for not initialing the citation; however, Applicants note that the document is in Japanese.

Applicants are therefore submitting herewith a Second Supplemental Information Disclosure Statement submitting pages 39-46 of this document, i.e., TSUNOOKA et al., "Industrial Development of Cationic Curing Technology," Material Stage, published by Technical Information Association, Vol. 2, No. 2, pp. 39-46 (May 10, 2002), accompanied by an English translation of a relevant portion and a newly-completed Form PTO-1449. The Examiner is therefore requested to confirm consideration of this document by including an initialed copy of the form with the next communication from the Patent and Trademark Office.

Response To Objection To Drawings

The drawings are objected to in that the Office Action asserts that Fig. 1 should labeled "PRIOR ART".

In response, Applicants note that Fig. 1 of the drawings includes an adhesive layer 7 using a sealer composed of the cationic polymerizable photosensitive composition of

Applicants' invention. In this regard, the Examiner's attention is directed to the paragraph discussing Fig. 1 beginning at page 24, line 4 of Applicants' specification.

Accordingly, this ground of objection should be withdrawn.

Rejection under 35 U.S.C. 112, Second Paragraph

In response to the rejection of claims 4 and 5 under 35 U.S.C. 112, second paragraph, because the Examiner asserts that the claims are indefinite, Applicants submit the following.

Applicants submit that claims 4 and 5 as pending prior to the present amendment are definite, because one having ordinary skill in the art would readily understand their scope. However, in order to advance prosecution of the application, the claims have been amended to delete the terms "general" and "various", and the parentheses appearing in the claims. In this regard, Applicants submit that the amendment to the claims is not intended to change the scope of the claims, but is merely being presented to delete extra words from the claims.

Art-Based Rejections

The following rejections are set forth in the Office Action.

- (a) Claims 6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,361,866 to Ogima et al. (hereinafter "Ogima")
- (b) Claims 1-4, 6-8, 10 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,361,866 to Ogima in view of EP 0831 127 (hereinafter EP '127').

(c) Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,361,866 to Ogima in view of EP '127, and further in view of JP10102026 A.

In response to these grounds of rejection, Applicants submit the following.

Regarding the anticipation rejection based upon Ogima, Applicants submit that this ground of rejection has been rendered moot in the claim 1 has been amended herein to include the subject matter of claim 2, which is not rejected based upon anticipation over Ogima. Therefore, the anticipation rejection should be withdrawn.

Regarding the rejections based upon obviousness over the combined disclosure of Ogima and EP '127 taken alone or with JP10102026 A (for claims 11 and 12), Applicants submit that these grounds of rejection are with appropriate basis and should be withdrawn.

Independent claim 1 is directed to a photosensitive composition comprising:
from 30 to 90 percent by weight of an epoxy compound (a) having two or more
epoxy groups in a molecule;
from 0.1 to 40 percent by weight of a polynuclear phenol compound (b)
comprising three to five phenolic aromatic rings, wherein either of the ortho positions of
each hydroxyl group is not substituted with any of a methylol group, or an alkyl group or
cycloalkyl group having four or more carbon atoms and each of two or more of the
phenolic aromatic rings has at least one unsubstituted position ortho to the hydroxyl
group;
from 0.1 to 10 percent by weight of an energy beam-sensitive cationic
polymerization initiator (c); and

from 1 to 60 percent by weight of a hydroxyl group-containing compound (d) having one or more hydroxyl groups and one or more of at least one of a vinyl ether group and an oxetanyl group in a molecule.

Accordingly, amongst the other features recited in claim 1, claim 1 includes from 1 to 60 percent by weight of a hydroxyl group-containing compound (d) having one or more hydroxyl groups and one or more of at least one of a vinyl ether group and an oxetanyl group in a molecule.

The obviousness rejection attempts to overcome this deficiency of Ogima (with respect to original claim 2) by relying upon the disclosure of EP '127 with the assertion that, "It would have been obvious to one skilled in the art at the time of the invention to include any of the polyols taught by EP '127 in the analogous compositions disclosed by Ogima et al. One skilled in the art at the time of the invention would have been motivated by a reasonable expectation of further polymerization of the epoxy-functional compounds with the polyols added."

In contrast to the assertions in the rejection, EP '127 does not appear to teach or suggest a hydroxyl group-containing compound (d) having one or more hydroxyl groups and one or more of at least one of a vinyl ether group and an oxetanyl group in a molecule, let alone the combination recited in Applicants' independent claim 1 and further patentably defined in the dependent claims.

As noted above, JP10102026 A is used for the rejection of claims 11 and 12, and does not overcome the deficiencies of either of Ogima or EP '127.

Accordingly, a *prima facie* case of obviousness has not been established for at least this reason.

Moreover, even if for the sake of argument a *prima facie* case of obviousness has been established, Applicants' claimed subject matter provides unexpected advantages. For example, attention is directed to Applicants' specification, at page 3, second paragraph, page 18, first paragraph, and Applicants' Examples, including Tables 1 and 2 on page 42. Thus, as disclosed, according to the present invention, photosensitivity which provides better curability and cured products having better adhesion and water resistance can be obtained by further using hydroxyl group-containing compounds (d). Such hydroxy group-containing compounds (d) are those compounds having one or more hydroxyl groups and one or more of at least one of a vinyl ether group and an oxetanyl group having cationic polymerizability in a molecule, and it is important that they have both a hydroxyl group and the above-described cationic polymerizable group in a molecule.

Accordingly, for at least this additional reason the obviousness rejection is without appropriate basis and should be withdrawn.

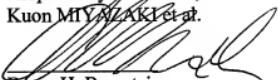
CONCLUSION

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the objection and rejections of record, and allow each of the pending claims.

Applicants therefore respectfully request that an early indication of allowance of the application be indicated by the mailing of the Notices of Allowance and Allowability.

Should the Examiner have any questions regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,
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